

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : TripleOne Inc..
Serial No. : 90/312526
Date Filed : November 11, 2020
Mark : DECENTRALIZED CONCEPT
Class Nos. : 42
Examiner : Catherine Caycedo
Law Office : 101

RESPONSE

Applicant submits the following remarks in response to the March 15, 2021 Office Action.

REMARKS

Section 2(e)(1) Refusal

The Examining Attorney has initially denied registration of Applicant's DECENTRALIZED CONCEPT mark for "computer services, namely, hosting and maintaining an on-line non-downloadable web site for others for crowdsourcing for business process improvement and idea and innovation management; computer services, namely, creating an on-line community for registered users to engage in crowdsourcing for business process improvement and idea and innovation management; computer services, namely, creating an on-line community for registered users to crowdsource business solutions and business challenges; providing a website featuring online non-downloadable software for management, control and monitoring of investment portfolios, through the internet and mobile non-downloadable application; providing temporary use of on-line non-downloadable software for stock portfolio management services of investment funds, public and private fixed income funds, cryptocurrencies and other financial assets; providing temporary use of on-line non-downloadable computer software providing and transmitting information and advice on the quotation of financial assets in general and on investment portfolios through a centralized control tool; providing temporary use of on-line non-downloadable computer software for portfolio simulation of investments and other financial assets, for information and education of potential investors; providing temporary use of on-line non-downloadable computer software for purchase

and sale of financial assets, approaching brokers and potential investors; providing temporary use of on-line non-downloadable computer software for the management of funds, namely, stock management, funds, fixed public and private income, crypto currencies and other financial resources; providing temporary use of on-line non-downloadable computer software that allows people or organizations to create a voting event, vote on the issue, change their vote at will and track the input; providing temporary use of on-line non-downloadable computer software for use in database management that features a point-based value system; providing temporary use of on-line non-downloadable computer software for managing job bank databases, web-based software for managing job applicants files, web-based software for managing the administration of competency, skills, traits of character and knowledge tests,” contending that the mark merely describes Applicant’s services under Section 2(e)(1) of the Trademark Act. Notably, the Examining Attorney has the burden of proving that Applicant’s mark is merely descriptive of the services in its identification. *See* T.M.E.P. § 1209.02. However, Applicant respectfully submits that a § 2(e)(1) refusal is improper in view of the at-most suggestive nature of the mark in the context of Applicant’s services.

DECENTRALIZED CONCEPT is at-most suggestive of the underlying services. Suggestive terms are those which require imagination, thought, or perception to reach a conclusion as to the nature of the goods or services. Thus, suggestive terms differ from descriptive terms, which *immediately* convey something about the underlying goods or services. T.M.E.P. § 1209.01(a) (citing *In re Shutts*, 217 U.S.P.Q. 363, 365 (T.T.A.B. 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool)).

Moreover, Applicant submits that a designation does not have to be devoid of all meaning in relation to the goods or services to be registrable. It is well established that to be characterized as “descriptive,” a mark or term must directly give some reasonably accurate or distinct knowledge of the characteristics of the product or service. If information about the product or service given by the mark or term is indirect or vague, then this indicates that it is being used in a “suggestive,” not descriptive, manner, enabling the mark’s registration on the Principal Register. *See Nautilus Grp. Inc. v. ICON Health & Fitness Inc.*, 372 F.3d 1330, 1340 (Fed. Cir. 2004) (holding that if consumers must employ a multi-stage reasoning process, rather than having an instantaneous understanding from the mark of an attribute of the product, then the mark is suggestive and not merely descriptive).

On this point, the Board's decision in *In re TMS Corp. of the Ams.* is particularly instructive. *See* 200 U.S.P.Q. 57, 59 (T.T.A.B. 1978). In *In re TMS Corp. of the Ams.*, the Board determined that THE MONEY SERVICE for money transfer services was too broad to describe the applicant's services with immediacy and particularity and was therefore suggestive, rather than descriptive. *See id.* The Board explained that because THE MONEY SERVICE was composed of commonly used English words, it suggested a number of things, yet fell short of describing the applicant's services with any degree of particularity.

Likewise, it is clear here that any ostensible meaning of the DECENTRALIZED CONCEPT mark as a whole in the context of Applicant's services is too vague and nebulous to merit a descriptiveness rejection. DECENTRALIZED CONCEPT does not immediately convey a quality, characteristic, feature, or purpose of Applicant's services when used in connection with the applied-for services. The mental leap between the mark and the services' attributes is not instantaneous. No consumer would see or hear DECENTRALIZED CONCEPT and instantly derive any information regarding the services that are offered in connection with the mark. Instead, a multi-stage reasoning process is required to understand that the mark alludes to Applicant's status as the world's first decentralized company. *See* Umesh Agarwal, *5 Ways TripleOne, the World's First Decentralized Company, Is Going to Change the Future of Business*, TECHBULLION (Feb. 6, 2021), <https://techbullion.com/5-ways-tripleone-the-worlds-first-decentralized-company-is-going-to-change-the-future-of-business/>, attached as **Exhibit A**.

The Office Action states that both the mark's "individual components and composite result are merely descriptive of applicant's identified software services which utilize decentralized concepts." This is not the case. Alternatively, DECENTRALIZED CONCEPT refers to Applicant's unique organizational structure and fact that Applicant is the world's first decentralized company that has no debt or investors. *See id.* The company is comprised of users, the people who join Applicant's company, around the world who contribute to the company's growth and management. *See id.* "[E]ach user is treated as the owner of the company," and "all users work together to build projects, complete tasks, and ensure the company's growth and development." *Id.* This structure combined with Applicant's lack of debt and investors is designed to make the decision-making process more efficient and allow all users to become entrepreneurs. *See id.* Accordingly, the proposed mark does not merely describe a quality, characteristic, feature, or purpose of Applicant's software services but rather refers to Applicant's organizational structure, the first of its kind, in a vague manner.

Even if consumers interpreted DECENTRALIZED CONCEPT as describing an aspect of Applicant's software services, the mark would not instantly convey any information. "Decentralized" lacks a universal definition in the software and computing context. As stated by distributed systems expert, Eric Elliott, "decentralized" in the computing and cryptocurrency context "may mean that any of these things are decentralized: access, organizational governance, computation, financial instruments, [or] wealth." Eric Elliott, *A Brief History of Decentralized Computing*, MEDIUM (Aug. 11, 2019), <https://medium.com/the-challenge/a-brief-history-of-decentralized-computing-d0d665783bcf>, attached as **Exhibit B**. For example, "decentralized computing" is when "critical application services are carried out by individual computing devices or nodes on a distributed network, with no central location." *Id.*; see also Gary Sharma, *The Imminent Decentralized Computing Revolution*, WALL STREET J. (Oct. 10, 2014), <https://www.wsj.com/articles/BL-232B-3134>, attached as **Exhibit C**. Decentralized computing architecture is characterized by the inability to "point to a single service address and disable it to shut down core application functionality for all users." Elliot, *supra*.

"Decentralized software" and "decentralized finance solutions" ("DeFis") have distinct connotations in the financial software context as well. Decentralized finance solutions "do not require the involvement of a middleman, such as a financial service provider. The general open-source nature of DeFi systems and voluntary participation" have prompted the creation of many blockchain-based lending systems. Christian Kameir, *How Decentralized Software Is Transforming Money*, FORBES (Jan. 28, 2021), <https://www.forbes.com/sites/forbesfinancecouncil/2021/01/28/how-decentralized-software-is-transforming-money/?sh=4835a5d0221b>, attached as **Exhibit D**. Consumers encountering Applicant's mark could easily presume that DECENTRALIZED CONCEPT has any of the foregoing meanings as applied to Applicant's services. Accordingly, because "decentralized" lacks a clear, well-known meaning in the software context, when consumers encounter the mark, "imagination, thought, or perception" is inevitably required to make an inference about the nature of Applicant's services. This is the hallmark of suggestive marks and obviates the § 2(e)(1) refusal.

Finally, in determining whether a term is merely descriptive as applied to the relevant services, any doubt should be resolved in the applicant's favor. See *In re Grand Metro. Foodservice, Inc.*, 30 U.S.P.Q.2d 1974, 1976 (T.T.A.B. 1994). Consequently, and for the reasons stated above, Applicant asks the Examining Attorney to withdraw the § 2(e)(1) refusal.

Prior-Filed Application Advisory

The Examining Attorney has issued a prior-filed application advisory, claiming that, if the mark depicted in U.S. Serial No. 79288734 issues to registration, Applicant's mark may be refused registration under Section 2(d) of the Trademark Act. Applicant elects not to submit arguments prior to the final disposition of U.S. Serial No. 79288734.